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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,708	03/06/2002	Hansen Yuan	2153 CIP DIV	7922
530 7590 05/14/2009 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER COMSTOCK, DAVID C				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
05/14/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/091,708

Applicant(s)

YUAN ET AL.

Examiner

DAVID COMSTOCK

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 71-83 and 85-106 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 71-79, 81-89 and 91-100 is/are rejected.
- 7) ☒ Claim(s) 80, 90 and 101-106 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 02 DEC 08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 81, 83, 85-89, 91 and 95-97 are rejected under 35 U.S.C. 102(e) as being anticipated by Jackson (US Patent Number 6,110,172), previously cited by examiner.

Jackson disclose a device for securing a spinal rod to the spine comprising a head portion defining a central axis extending from an upper end to a lower end of the head portion, wherein the head portion has a channel extending therethrough oriented perpendicular to the central axis and configured to receive a spinal rod, wherein the head portion has opposed walls with arcuate engagement slots, e.g. 22 and 23 (see figure 2) and a seat (see figure 2) a two-part locking cap including an upper portion/first portion (see figure 4) having opposed arcuated inclined engagement flanges, e.g. 40 and 41, (see figure 4) cammingly engageable with an interior surface of the head portion (see figures 1 and 7) and a lower portion/second portion, (see figure 4) having an elongated recess, e.g. 68, for engaging an exterior surface of a spinal rod received by the channel (see column 5, lines 32-34), wherein the upper portion and the lower portion of the locking cap are mechanically coupled together, e.g. by threads, by an

arcuate axial post, e.g. 4, wherein the upper portion of the locking cap is capable of being rotated relative to the head portion (see column 5, lines 26-28), wherein the first portion of the locking cap is located above the second portion of the locking cap as the locking cap moves from an unlocked to a locked position, wherein the first portion of the locking cap is spaced from the spinal rod when the locking cap is in the locked position (see figure 7), and a fastener portion, e.g. 2, depending from the lower end of the head portion, wherein the head portion is formed monolithic with the fastener portion (see figure 1).

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Jackson, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 71-79, 82, 92-94 and 98-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (US Patent Number 6,110,172), previously cited by examiner in view of Puno et al. (US Patent Number 5,360,431), previously cited by examiner

Jackson discloses the claimed invention (see above) except for the fastener portion being movable relative to the head portion and the fastener including a spherical head and a threaded body depending from the spherical head. Puno et al. disclose a device for securing a spinal rod to the spine comprising a movable fastener portion, e.g. 21, including a spherical head, e.g. 30, and a threaded body, e.g. 21, depending from the spherical head (see figures 2-7) and teach that the screw is separate from the anchor seat in order to provide limited motion between the anchor seat and the vertebrae and to act as a shock-absorber (see column 3, lines 64-68 and column 4, lines 1-5). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Jackson with the fastener portion being movable relative to the head portion and the fastener including a spherical head and a threaded body depending from the spherical head, in view of Puno et al., in order to provide limited motion between the anchor seat and the vertebrae and to act as a shock-absorber.

Allowable Subject Matter

Claims 80, 90 and 101-106 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 71-83 and 85-106 have been considered but are not persuasive.

Applicant argues that the previous Examiner indicated that the rejection should be withdrawn because the art allegedly does not show the claimed features. However, while full faith and credit is given to the previous Examiner where possible, it is believed that Jackson in fact comprises arcuate engagement flanges receivable in arcuate engagement slots of the head portion (best seen in Figs. 4 and 7, both the flanges and slots comprise an arcuate shape). Nevertheless, since Applicant relied on Examiner's finding in replying to the previous rejection, this Office action is made non-final. New claims 101-106 present allowable subject matter.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710 (a detailed message should be left if Examiner is unavailable). If attempts to

reach the Examiner by telephone or voicemail are unsuccessful, the examiner's supervisor, Eduardo Robert, can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733